

REMARKS/ARGUMENTS

This Response is filed in response to a Final Office Action dated September 1, 2006.

Upon entry of this response, claims 17-19, 21-23, 26-28, 30-32, 34, 36 and 38-39 will be pending in the Application.

In the outstanding Office Action, the Examiner rejected claims 17-19, 21-23, 26-28, 30-32, 34, 36 and 38-39 under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement and failing to comply with the written description requirement.

Rejection under 35 U.S.C. § 112, First Paragraph

The Examiner rejected claim 17-19, 21-23, 26-28, 30-32, 34, 36 and 38-39 under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement and the written description requirement. In addition, the Examiner rejected claims 17-19, 21-23, 26-28, 30-32, 34, 36 and 38-39 under 35 U.S.C. § 112, first paragraph, as containing new matter. The Examiner further indicated that the Declaration of Andrew Skoog filed June 22, 2006 was considered but maintained that the claims, including the limitation “the particles being physically separated from one another”, remain non-enabled. Specifically, the Examiner stated the following:

1. Claims 17-19, 21-23, 26-28, 30-32, 34, 36, and 38-39 remain rejected under 35 USC 112, 1st paragraph. The 37 CFR 1.132 Declaration filed June 22, 2006 has been considered. However it is the Examiner's position that the limitation "the particles being physically separated from one another" in claims 17, 26, and 32 remains non-enabled in the specification. While the Declaration states that "The physical separation of the particles within the coating medium is due to the surface tension of the selected particle and the viscosity of the coating medium," the specification and Declaration provide no indication of how to choose a surface tension and viscosity resulting in physical separation of particles, what are exemplary values or ranges would provide the claimed separation, etc. An artisan having ordinary skill in the art would not know, using the disclosure as a guide, what specific materials and conditions are required to make the coating medium such that a barrier layer is formed around the particles resulting in physical separation. It is the Examiner's position that not every combination of a non-metallic medium having non-spherical metal particles therein would result in a fluid condition where the particles are all physically separated from one another. The description on pages 14 and 15 (cited in the Declaration) provides no mention of the physical separation of particles, much less selecting a surface tension of the selected particle and viscosity of the coating medium such that physical separation is achieved. As stated before, there is no teaching how to make the claimed invention, specifically how to make and maintain the particles physically separated from one another.

The Examiner further cites MPEP 716.09 in support for the position.

Applicant submits that there is no indication in the specification, in the figures or elsewhere indicating that the figures do not represent the present invention and the Examiner has not pointed to any evidence establishing that the figures do not represent the present invention. Furthermore, the Examiner has not cited any authority to dismiss

the disclosure (i.e., the figures), as originally filed, as support for the claims. Merely stating that the figures are schematic is insufficient to establish that the claims are non-enabled.

Nonetheless in order to support the argument that these figures are more than simply schematic, the second Declaration of Andrew Skoog is being provided with this response.

In response to the Examiner's rejection, Applicants submit a second declaration of Andy Skoog under 37 C.F.R. § 1.132 providing both factual support for the limitation "the particles being physically separated from one another" and evidence that the limitation is enabled by the present invention. The declaration provides evidence of the scientific principles governing the physical separation of the magnetic particles and does not merely explain or interpret the disclosure, see e.g., MPEP 716.09. As indicated in the declaration, *explicit* support for the physical separation of the magnetic particles within the coating medium is shown in, among other locations, Figures 5-10 of the specification (see Paragraph 4 of Declaration). The Applicant maintains that this disclosure (i.e., the disclosure present in the figures) is sufficient to enable the disclosure; however, the Examiner has taken the position that these figures are merely schematic.

Declarant Skoog explains the physical separation of the magnetic particles within the coating medium is shown explicitly in FIGs. 5-10 (see Paragraph 5 of Declaration). Declarant Skoog further explains that a barrier layer, specifically an oxide layer, more specifically an aluminum oxide layer, constitutes the barrier layer and prevents particle-to-particle contact while allowing movement of the individual particles within the medium (see Paragraphs 6 and 7 of Declaration). Declarant Skoog notes that the particles selected including those exemplified in the specification, *inter alia*, at page 12, lines 7-8 and in U.S. Patent No.5,827,445 necessarily have oxide layers (see Paragraphs 6, 7, 8 and 9 of Declaration). As noted by Declarant Skoog, the

examples in the specification provide sufficient guidance to one of ordinary skill in the art to practice the invention (see Paragraph 10 of Declaration). All of the above are based on the specification as originally filed, including specific examples disclosed therein (see specification page 12, lines 7-8; page 6, lines 11-15 and page 12, lines 13-14). These examples, including the specific compounds and the methods for assembling the compounds, clearly provide guidance to one of ordinary skill in the art and clearly teaches one of ordinary skill in the art to make and use the invention, see e.g., MPEP 2164.

Given the above factual evidence presented in the Declaration of Andrew J. Skoog, Applicant submits that the limitation, "the particles being physically separated from one another", is both supported by the specification as originally filed and enabled by the specification as originally filed. Accordingly, Applicants respectfully request withdrawal of the rejections under 35 U.S.C. § 112, first paragraph.

In addition, Applicant notes that the explicit support for the physical separation of the magnetic particles within the coating medium is shown in, among other locations, Figures 5-10 of the specification (see Paragraph 4 of Declaration) is sufficient support for the claim limitation and does not constitute new matter. Accordingly, Applicants respectfully request withdrawal of the rejection under 35 U.S.C. § 112, first paragraph for new matter.

CONCLUSION

In view of the above, Applicants respectfully request reconsideration of the Application and withdrawal of the outstanding rejections. As a result of the remarks presented herein and the submission of the second declaration under 37 C.F.R. § 1.132, Applicants respectfully request withdrawal of the rejections under 35 U.S.C. 112, first paragraph and submit that claims 17-19, 21-23, 26-28, 30-32, 34, 36 and 38-39 are thus in condition for allowance and do not include new matter. As the claims are not anticipated

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nor rendered obvious by the applied art in view of the applied art and the claims and enabled and supported by the specification as originally filed, Applicants request allowance of claims 17-19, 21-23, 26-28, 30-32, 34, 36 and 38-39 in a timely manner. If the Examiner believes that prosecution of this Application could be expedited by a telephone conference, the Examiner is encouraged to contact the Applicants.

The Commissioner is hereby authorized to charge any additional fees and credit any overpayments to Deposit Account No. 50-1059.

Respectfully submitted,
MCNEES WALLACE & NURICK LLC

/Andrew L. Oltmans/

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Andrew L. Oltmans
Reg. No. 56,074
100 Pine Street
P.O. Box 1166
Harrisburg, PA 17108-1166
Attorney for Applicants
Tel: (717) 237-5281
Fax: (717) 237-5300